



Attorney Docket No.: 97-106 CIP
Serial No.: 09/145,690

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Charles J. Long, Jr.

Serial No.: 09/145,690

Filed: September 2, 1998

Group Art Unit: 3727

Examiner: Hylton, Robin/Cronin, Stephen

Our Ref: 97-106 CIP

SNAP-ON SCREW-OFF
CLOSURE

13/2pm
9/18/00
Petition

Commissioner of Patents and Trademarks
Washington DC 20231

August 18, 2000

Sir/Madam:

**PETITION TO THE COMMISSIONER PURSUANT TO 37 C.F.R. 1.181
FOR ENTRY OF AMENDMENT AFTER FINAL REJECTION;
AND REQUEST FOR RECONSIDERATION PURSUANT TO 37 C.F.R. 1.116**

In response to the Examiner's Advisory Action on the above identified application mailed July 21, 2000, Applicant respectfully petitions the Commissioner, pursuant to 37 C.F.R. 1.181, for entry of the amendments to the above-identified application presented in the AMENDMENT filed by Applicant on July 6, 2000 (appended hereto as Exhibit "1"); and also requests reconsideration and allowance of the present application pursuant to 37 C.F.R. 1.116, based on the aforesaid amendments and the reasons set forth below.

The Examiner has refused entry of the aforesaid amendments, which were necessitated by final rejection of the claims and were not earlier presented for that reason, based on the claim that

they (i) raise new issues that would require further consideration and/or search; and (ii) are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. Specifically, the Examiner contends that the amended claims as proposed do not overcome the combination/subcombination rejection set forth in the final Office Action dated March 28, 2000, and that the amendments raise new issues with respect to the combination of the closure and container. Applicant respectfully traverses and requests the Commissioner to overrule the Examiner's refusal to enter the amendments presented in Exhibit "1", on the basis that the aforesaid amendments add no new subject matter to that already present in the claims before the final rejection was made, and thus raise no new issues requiring further consideration and/or search.

The amendments presented to Claims 7 and 8 in the AMENDMENT of Exhibit "1" address the 35 U.S.C. § 112 rejections raised by the Examiner in the final Office Action and present no new subject matter. Instead, these amendments make changes of only an editorial nature that are intended to place the claims in a condition for allowance by overcoming those rejections. Furthermore, the refusal to enter these amendments is improper as both Claims 7 and 8 multiply depend from Claim 25 -- itself a combination claim to which the combination/subcombination rejection in the final Office Action is inapplicable.

Because they present no new matter, these amendments raise no issue of lack of proper disclosure or undue breadth. As a consequence, the 35 U.S.C. § 112 rejections raised in the final Office Action are considered to be "technical" in nature under the standards of the Manual of Patent Examining Procedure (MPEP), and Applicant's attempt to amend the claims to overcome these rejections should not be refused consideration on appeal if those amendments would

otherwise place the application in a condition for allowance over the prior art. See MPEP § 706.03:

The primary object of the examination of an application is to determine whether or not the claims are patentable over the prior art. This consideration should not be relegated to a secondary position while undue emphasis is given to nonprior art or "technical" rejections. Effort in examining should be concentrated on truly essential matters, minimizing or eliminating effort on technical rejections which are not really critical. Where a major technical rejection is proper (e.g., lack of proper disclosure, undue breadth, utility, etc.) such rejection should be stated with a full development of the reasons rather than by a mere conclusion coupled with some stereotyped expression.

Moreover, separate and apart from the amendments to Claims 7 and 8, the proposed amendments to Claims 1, 22 and 25 only incorporate the previously-examined limitations of cancelled Claims 21, 23 and 24 and thus raise no new issues. Moreover, these amendments in fact place the case in better form for appeal, by reducing the questions presented on prior art to the single consideration of whether the remaining claims are allowable under 35 U.S.C. § 103 in light of the combination of U.S. Patent No. 4,448,319 to Kern with U.S. Patent No. 5,056,675 to Julian, which was the only asserted basis for rejection of the cancelled claims over prior art.

Presumably, in reviewing the AMENDMENT of Exhibit "1", the Examiner has followed the requirements of MPEP § 714.13 (i.e., *"the proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified.... Applicants should be notified, if certain portions of the amendment would be acceptable as placing some of the claims in better form for appeal...."*) By eliminating all prior art issues except for one, the amendments must at the very least be considered to place the claims in a better form for appeal by materially reducing and/or

simplifying the issues for appeal, and thus should be entered. See MPEP § 714.12 ("*[a]ny amendment that will place the case either in a condition for allowance or in better form for appeal may be entered. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 C.F.R. § 1.116(a).*")

In response to the Office Action mailed March 28, 2000 finally rejecting the claims of the above-identified application, Applicant thus respectfully requests entry of the amendments presented in the AMENDMENT filed on July 6, 2000 (appended hereto as Exhibit "1"). Additionally, reconsideration and allowance of the appealed claims, as so amended, is respectfully requested based on the reasons set forth in the aforesaid AMENDMENT.

The Commissioner is hereby authorized to charge Deposit Account No. 03-2026 in the amount of \$130 as the Petition fee for filing this Petition and for any additional fees required.

Respectfully submitted,
CHARLES J. LONG, JR.

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